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09/938,802	08/24/2001	Sanjeev Dharap	YAHOO-01009US1	2167

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EXAMINER

VON BUHR, MARIA N

ART UNIT	PAPER NUMBER
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2125

DATE MAILED: 03/19/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/938,802

Applicant(s)

DHARAP, SANJEEV

Examiner

Maria N. Von Buhr

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 1-28 are pending in this application.
2. Applicant's claim for domestic priority under 35 U.S.C. §119(e) is acknowledged.
3. Examiner acknowledges receipt of Applicant's information disclosure statement, received January 7, 2002, with accompanying reference copies, which have been taken into consideration for this Office action.
4. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP §608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The specification is objected to because of the use of inconsistent terminology, such as on page 2, where the following inconsistencies are evident; "user agent 10" and "WAP client 10;" "WAP gateway 20" and "WAP server 20." These are just examples of the inconsistencies in the description of the instant invention. Applicant is encouraged to review the specification for any further such informalities, and to correct them as appropriate.
6. The following is a quotation of the second paragraph of 35 U.S.C. §112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which Applicant regards as his invention.
7. Claims 1-10, 15, 16, 22, 23, 25, 26 and 28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, there is no nexus between the steps, which presents ambiguity with regard to the flow of the method/process of converting the list into an abbreviated list (i.e.; what's the purpose of alphabetizing the list, if the abbreviating is done on the original list?). Also, it is unclear how this alphabetizing/

abbreviating accomplishes sending of the whole data list in abbreviated form across a wireless network. It would appear from the steps presented that all of the original data list would still need to be transmitted, in order for it to be accessible over the network.

In claim 2, there is no clear and proper antecedent basis for "the members," since inconsistent terminology has been used. Also, the claim would appear to generate a redundant abbreviated list, or no list at all, dependent upon interpretation of the instant claim language "wherein each entry in the second abbreviated list represents at least one set represented by the at least one entry of the first abbreviated list." It would appear that the claim language would necessitate the presence of more than one entry and more than one set in the first abbreviated list, in order for the second abbreviated list to be generated.

In claims 7, 9 and 28, there is no clear and proper antecedent basis for "the list," since a plurality of lists (the original one, "abbreviated" one and "alphabetized" one) have previously been provided for. Further in claim 28, "a next sequential letter in each said data item" has no clear antecedence.

In claims 15 and 26, the first line is grammatically awkward, and there is no clear and proper antecedent basis for "said first of said same first letters."

In claim 22, there is no clear and proper antecedent basis for "the members of the set."

Claims 23 is grammatically awkward.

In claim 25, there is no clear and proper antecedent basis for "said same first characters," "said multiple ones of said sets" nor "said sets mapped to said one input controller."

The remainder of the claims stand rejected as necessarily incorporating the above-noted ambiguities of their parent claims.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-28 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Weiser et al. (U.S. Patent No. 5,786,819), which discloses a method for searching long lists which abbreviates those lists for transmission over a wireless network and display on a hand held device (see at least the abstract; Figs. 1 and 2; col. 3, lines 65-67; col. 4, line 42 - col. 5, line 14; col. 6, lines 6-43 and 60-65; col. 7, lines 15-27 and 43-47).

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

11. Any response to this Office action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to the Office at:**

(703) 746-7239 - for formal communications intended for entry, mark "FORMAL";  
(703) 746-7240 - for informal/draft communications; label "PROPOSED" or "DRAFT".

Hand-delivered papers should be brought to Crystal Park II, 2121 Crystal Dr., Arlington, VA, 4th Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Maria N. Von Buhr whose telephone number is (703) 305-3837. The Examiner can normally be reached on Monday-Friday between 9:00 A.M. and 5:00 P.M.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Leo Picard can be reached at (703) 308-0538.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



MARIA N. VON BUHR  
PRIMARY PATENT EXAMINER  
ART UNIT 2125

MNVB  
3/5/03